

REMARKS

Claims 1, 2 and 4-12 are pending in the application and are at issue.

This amendment is submitted in accordance with 37 C.F.R. §1.116 (a) and §1.116 (b) in order to present the rejected claims in a better form for allowance or appeal. The amendment is necessary to eliminate rejections under 35 U.S.C. §112, first and second paragraphs, and to overcome the withdrawal of claims 11 and 12 from the application. This amendment was not presented earlier because the rejections under 35 U.S.C. §112, first and second paragraphs, are new grounds of rejection. Furthermore, the withdrawal of claims 11 and 12 were first brought to applicants' attention in the Office Action of January 24, 2007. This amendment should be entered because it places the application in better form for allowance or appeal, and the amendment does not require further searching or present any new issues.

Claims 11 and 12 have been withdrawn from consideration for reciting a "method," whereas examined claims 1, 2, and 4-10 are directed to a composition. Claims 11 and 12 were first presented in the amendment filed November 3, 2006, and due to a typographical error recited a "method" rather than a "composition". It is evident that applicants intended to recite a dependent composition in claims 11 and 12, demonstrated by the following except from page 5 of the amendment filed November 3, 2006.

"Claim 1 and 10 also have been amended to recite an average diameter for the visible particles. New claims 11 and 12 also recite an average diameter for the visible particles. Support for this amendment and new claims can be found in the specification at page 5, lines 15-17"

Claims 11 and 12 have been amended to correct this obvious typographical error, and it is submitted that the withdrawal of claims 11 and 12 should be withdrawn. Amended claims 11 and 12 present no new issues and require no additional searching because these claims recite a narrow particle size range than claims 1 and 10, and no art is presently cited against the broader claims 1 and 10.

Claims 1, 2 and 4-10 stand rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement and the enablement requirement. The examiner contends that the specification fails to disclose the recited term "free of surfactant" and that the specification fails to teach or use an inventive composition that is "free of surfactant". Applicants transverse these rejections.

The term "free of surfactant" is explicitly taught in Examples 1-12 of the specification. In particular, the specification contains twelve total examples at pages 53-56. *Each* of these examples is *free of a surfactant*, which shows that the inventors had possession of the presently claimed invention at the time of filing the application. The examiner is specifically directed to the "Definition of Components" present in the examples at pages 55 and 56 of the specification. Note that *not one* of the 36 defined ingredients used in Examples 1-12 is a surfactant.

Not only have applicants demonstrated that they possessed the claimed invention at the time of filing the application, thereby complying with the written description requirement, applicants also have enabled persons skilled in the art to make and use the invention. In particular, the applicants provided twelve examples free of surfactant, *and* the applicants specifically teach how to make the surfactant-free compositions, at page 56, line 27 through page 57, line 3, under the title "Method of Preparation". Therefore, applicants not only have provided numerous examples of the presently claimed invention, but also has specifically provided instructions to persons skilled in the art as to how to make the surfactant-free composition.

The examiner may be concerned that the specification does not specifically state the term "free of surfactant". However, it is settled law that a claim term does not have to recited *in haec verba* in the specification. To comply with 35 U.S.C. §112, first paragraph, all that has to demonstrated is whether applicants' disclosure has conveyed sufficient information to those skilled in the art that the applicants have invented the claimed subject matter. Applicants have met this burden in Examples 1-12 of the specification. As stated in MPEP §2163, "[I]t is now well accepted that a satisfactory description may be in the claims *or in any other portion* of the originally filed specification" (emphasis added). Support for a claim limitation can be express, implicit, or inherent.

Applicants have provided sufficient information in the disclosure to inform those skilled in the art that applicants invented the claimed composition. Only surfactant-free compositions are provided as examples. The MPEP goes on to state that the claimed invention can be described in words, structures, figures, diagrams, and formulas. Possession of the invention also may be shown by a reduction to practice, including testing of the claimed invention, which applicants have done in Examples 1-12.

A contention that because the term "free of surfactant" is not recited in the disclosure, the specification therefore contains no basis for the term. This reasoning has been found clearly erroneous in *In re Wright*, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989). Wherein the court stated:

"...in *In re Smith*, 481 F.2d 910, 914, 178 U.S.P.Q. 620, 624 (CCPA 1973. As our predecessor court said in that case:

The specification as originally filed must convey clearly to those skilled in the art the information that the applicant has invented the specific subject matter later claimed. *In re Ruschig*, supra, 54 CCPA at 1559, 379 F.2d at 996, 154 USPQ at 123. When the original specification accomplishes that, regardless of how it accomplishes it, the essential goal of the description is realized.

In deciding the issue, the specification as a whole must be considered.

As also pointed out in *Smith* and as admitted by the board, "the claimed subject matter need not be described in haec verba in the specification in order for the specification to satisfy the description requirement." The fact, therefore, that the exact words here in question, "not permanently fixed", are not in the specification is not important. From the wording of the examiner's rejection it would seem that he did not know that; at least he wanted to be shown an "unequivocal teaching" that the microcapsules are not permanently fixed."...

...All of this convinces us that it is of the essence of the original disclosure that the microcapsules are "not permanently fixed" to their various supports. The examiner was therefore wrong in his underlying premise that the limitation added to the claim by amendment contained "new matter".

The specification does unequivocally teach the absence of permanently fixed microcapsules. The §112 rejection was

clearly erroneous and cannot stand. There is clear compliance with the description requirement."

Therefore, considering the present specification as a whole, particularly in light of the information disclosed in the examples, applicants have adequately informed those skilled in the art that the composition is free of surfactant. See MPEP, § 2163, II, A, 2, wherein the entire specification, including specific embodiments should be considered. Accordingly, it is submitted that the examiner's rejection is erroneous and that the final rejection of claims 1, 2 and 4-10 under 35 U.S.C. §112 should be withdrawn.

It is also submitted that claims 11 and 12 also fully comply with 35 U.S.C. §112, first paragraph and second paragraph.

Claim 2 also stands rejected under 35 U.S.C. §112, second paragraph. However, like applicant's inadvertent error is in reciting "method" in claims 11 and 12, this appear to be a typographical error, and that the rejection actually is directed to paragraph (2) claim 1. It is submitted that this rejection is in error because applicants prior filed amendment changed "a visible particle" to "visible particles". The "a" was "struck out" in previous amendment. Accordingly, the rejection to claim 1 (2) is erroneous. However, applicants clarified claim 1(2) and claim 10(2) by reciting "particles," rather than "particle".

Claim 10 is objected to because subparagraph (5) recites "additional viscosity modifier", which lacks antecedent basis. Claim 10(5) has been amended to recite "a viscosity modifier", thereby overcoming this rejection of claim 10.

It is submitted that all pending claims are in a form and scope for allowance. An early and favorably action on the merits is respectfully requested.

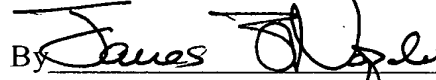
Application No. 09/744,269
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Docket No.: 30766/40000

Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, the examiner is urged to telephone the undersigned at the indicated number.

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Respectfully submitted,

By 

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